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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,907	09/18/2001	Jean-Claude Beauvillain	208888USOPCT	3062
22850	7590	05/05/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SULLIVAN, DANIEL M	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/831,907

**Applicant(s)**

BEAUVILLAIN ET AL.

**Examiner**

Daniel M Sullivan

**Art Unit**

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,9,10 and 14-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,9,10,14,15 and 18-26 is/are rejected.
- 7) ☒ Claim(s) 16 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1 March 2004 has been entered.

Claims 1, 9, 10 and 14-17 were considered in the Office Action mailed 26 January 2004. Claims 2-8 and 11-13 were canceled, claims 1, 9, 14 and 15 were amended and claims 18-26 were added in the 1 March Paper. Claims 1, 9, 10 and 14-26 are presently pending and under consideration.

### ***Response to Amendment***

#### **Claim Rejections - 35 USC § 112**

Claims 9 and 10 stand rejected and claims 18-23 are newly rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for reasons of record and herein below in the response to arguments. Newly added claims 18-23 are directed to specific embodiments of the composition of claim 9 and the method of claim 10. As such they lack enablement for the reasons set forth in previous Office Actions regarding enablement for claims 9 and 10.

Art Unit: 1636

Claim Rejections - 35 USC § 102

Claims 1, 9, 14 and 15 stand rejected, and claims 18, 21 and 24 are newly rejected under 35 U.S.C. 102(e) as being anticipated by Culp *et al.* U.S. Patent No. 6,075,137 for reasons of record and herein below in the response to arguments. Claims 18, 21 and 24 are directed to specific embodiments of claims 9, 10 and 14 wherein the polypeptide includes the polypeptide comprising SEQ ID NO: 2; therefore, the claims are properly rejected as anticipated under 35 U.S.C. 102(e) as being anticipated by Culp *et al.* for reasons set forth in previous Office Actions.

***Response to Arguments***

In response to the outstanding rejections, Applicants express their gratitude for the indication that amending the claims to recite “consisting of” would overcome the rejections of record. However, the remarks do not specifically indicate where this statement can be found, and the Examiner can find no such statement in the prosecution history. In particular, the statements of record regarding lack of enablement for claims directed to pharmaceutical compositions and methods of making a medicinal product clearly convey that the claims are not enabled regardless of whether the polypeptide is limited to comprising or consisting of the sequence.

With regard to the art rejection, the amendment to claims 1 and 9, wherein “consisting of” replaces “comprising” in line two, has essentially no effect on the scope of the claims because “consisting of” is read as limiting the heptapeptide comprised within SEQ ID NO: 2 and not as limiting the entire protein to comprising only SEQ ID NO: 2. As the C-terminal end of the polypeptide described by Culp *et al.* does, in fact, consist of the peptide of the claims, the claims are anticipated by Culp *et al.* for the reasons of record.

Art Unit: 1636

The remainder of Applicant's arguments are a *verbatim* reiteration of the remarks that accompanied the 26 January 2004 Amendment after final, which were addressed in the 26 January Office Action.

### ***New Grounds***

#### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 is indefinite because it is unclear what "activity" identifies a compound as an anti-hypertensive. Is the ability of a compound to antagonize urotensin the "activity" that identifies a compound as an candidate anti-hypertensive? If so, what is antagonized by candidate anti-hypertensives? For example, many compounds capable of antagonizing the binding of a ligand to its receptor also act as agonists and mimic the functional properties of the ligand.

Claims 24-26 are indefinite insofar as they depend from claim 14.

Claims 22 and 23 are indefinite in being directed to the method of claim 9. Claim 9 is directed to a product. In the interest of compact prosecution, the claims have been examined with the assumption that Applicant intends that they depend from claim 10.

### ***Allowable Subject Matter***

Art Unit: 1636

Claims 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M Sullivan whose telephone number is 571-272-0779. The examiner can normally be reached on Monday through Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DMS

  
DAVID GUZO  
PRIMARY EXAMINER